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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/671,860 | 09/25/2003 | Koichi Ito | 2487 | 8675 |
| 7617 | 7590 | 02/09/2005 | EXAMINER | |
| BRUZGA & ASSOCIATES 11 BROADWAY, STE 400 NEW YORK, NY 10004 | | | CHANG, VICTOR S | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1771 | |

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

[Handwritten mark]

Office Action Summary

| | | |
|--------------------------------------|------------------------------------|--|
| Application No. 10/671,860 | Applicant(s) ITO, KOICHI | |
| Examiner Victor S Chang | Art Unit 1771 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-109 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) _____ is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) 1-109 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 - 1. Certified copies of the priority documents have been received.
 - 2. Certified copies of the priority documents have been received in Application No. _____.
 - 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-51, drawn to a method for coating a porous polyurethane resin with an aromatic isocyanate coating composition, classified in class 427, subclass various.
 - II. Claims 52-101, drawn to a porous polyurethane product comprising a porous polyurethane resin substrate and at least one coating comprising a primary layer having reactive OH group and a secondary layer having reactive NCO group, classified in class 428, subclass 304.4.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions Group I and Group II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process, such as coextrusion.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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4. This application also contains claims directed to the following patentably distinct species of the claimed invention:

Species Group I: Primary Layer Composition (claims unspecified are generic to this group.)

Species A (claims 3, 4, 30, 31, 54-57 and 81): polyvinyl alcohol (PVOH), or PVOH/polyvinyl acetate (PVA) copolymer.

Species B (claims 5-7, 32-34, 58-60 and 82-84): carboxymethylcellulose.

Species C (claims 8-10, 35-37, 61-63 and 85-87): starch.

Species D (claims 11-13, 38-40, 64-66 and 88-90): sodium or ammonium polyacrylate.

Species E (claims 14-16, 41-43, 67-69 and 91-93): polyacrylic acid.

Species F (claims 17-19, 44-46, 70-72 and 94-96): sodium polycarboxylate.

Species G (claims 20-22, 47-49, 73-75 and 97-99): alkyl (meth)acrylate.

Species H (claims 23, 24, 50, 51, 76, 77, 100 and 101): gum arabic.

Species Group II: Aromatic Isocyanate Coating Composition (claims unspecified are generic to this group.)

Species I (claim 25): water-based polyurethane paint.

Species J (claim 26): solvent-based polyurethane paint.

Species Group III: Aromatic Isocyanate Compound (claims unspecified are generic to this group.)

Species K (claims 102 and 104): 4, 4'-diphenylmethane diisocyanate.

Species L (claims 103 and 104): hexamethylene diisocyanate.

Species M (claim 104): 1, 5-naphthalene diisocyanate.

Species N (claim 104): toluene diisocyanate.

Species O (claim 104): o-tolidine diisocyanate.

Species P (claim 104): XDI.

Species Q (claim 104): hydro XDI.

Species R (claim 104): hydro 4, 4'-diphenylmethane diisocyanate.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species from each of Species Groups I-III as set forth above for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Claims not mutually elected will be withdrawn.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record

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showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Victor S Chang
Examiner
Art Unit 1771

2/5/2005